

### REMARKS

#### Rejection of Claims 33-37 Under 35 U.S.C. § 112, 1<sup>st</sup> Paragraph, Enablement

The Examiner has maintained the rejection of claims 33-37 "because the specification, while being enabled for claims limited in scope to a polypeptide of SEQ ID NO:2, and a polypeptide of SEQ ID NO:2 lacking is associated signal peptide, does not reasonably provide enablement for claims to various % variants of SEQ ID NO:2, which do not have a functional activity, or do not have the same functional activity as SEQ ID NO:2." According to the Examiner, "the issue is that the present claims encompass inactive polypeptides as there is no functional limitation associated with the claimed polypeptide variants, and the specification does not teach how to use those inactive variants of SEQ ID NO:2."

As an initial matter, Applicant notes that the mere possibility that a genus claim may encompass "inoperative" species is not a proper basis for holding the claim to define an invention that is not enabled by the specification. However, to expedite examination and put the application in better form for appeal, Applicant has amended the claims to add a functional limitation that addresses the Examiner's concerns regarding the question of coverage of the claims (i.e., to "inactive" variants). In view of this amendment, Applicant respectfully requests that the Examiner withdraw the rejection of claims 33-37 on the basis of §112, first paragraph (enablement). Support for such amendment can be found in the application at, for example, Example 13. Accordingly, the amendment does not constitute new matter.

#### Rejection of Claims 33-37 Under 35 U.S.C. § 112, 1<sup>st</sup> Paragraph, Written Description

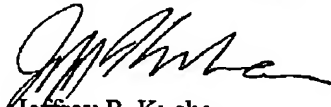
The Examiner has maintained the rejection of claims 33 to 37 as "containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." The Examiner states that "the claims are drawn to a genus of polypeptides that is defined only by % sequence identity to a particular polypeptide sequence, and no particular conserved structure or other disclosed distinguishing feature is required."

Applicant submits that the amendment made by the present response to the claims address the Examiner's concerns and respectfully requests that the Examiner withdraw the rejection of claims 33-37 on the basis of §112, first paragraph (written description). Support for such amendment can be found in the application at, for example, Example 13. Accordingly, the amendment does not constitute new matter.

Additional Comments

Applicant believes that the instant amendment places the application in a better form for appeal, but does not constitute new matter or require further consideration and/or search. Acceptance and entrance of the amendment, therefore, is respectfully requested. If the Examiner believes that the current amendment will not be entered, Applicant requests that the Examiner contact the undersigned prior to taking any further action in this application.

Respectfully submitted,  
for GENENTECH, INC.



Jeffrey P. Kushan  
Registration No. 43,401

Date: February 15, 2005